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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,075

06/22/2005

Mario Rottlander

421-US-PCT

2734

45821 7590 03/21/2007

LUNDBECK RESEARCH USA, INC.

ATTENTION: STEPHEN G. KALINCHAK, LEGAL

215 COLLEGE ROAD

PARAMUS, NJ 07652

EXAMINER

LAMBKIN, DEBORAH C

ART UNIT

PAPER NUMBER

1626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/540,075	Applicant(s) ROTTLANDER ET AL.	
	Examiner Deborah C. Lambkin	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 26-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20 and 26-32 is/are rejected.
- 7) ☐ Claim(s) 1-10 and 12-19 is/are objected to.
- 8) ☒ Claim(s) 1-20 and 26-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

DEBORAH C. LAMBKIN
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/22/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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Election/Restrictions

Applicant's election with traverse of Group I in the reply filed on 1/26/07 is acknowledged. The traversal is on the ground(s) that to search all the compounds is not an undue burden. This is not found persuasive because in all due respect to applicant this is not an error in the restriction set forth and in fact there is an undue burden to search all the compounds in one application.

The requirement is still deemed proper and is therefore made FINAL.

Applicant is requested to amend the claims to the elected subject matter.

Allowable Subject Matter

Claims 1-10, 12-20 and 26-32 are allowed in so far as they read on the elected subject matter.

Claim Objections

Claims 1-10, 12-20 and 26-32 objected to for containing non-elected subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 20 and 26-32 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the treatment of one disease or disorder, does not reasonably provide enablement for the prevention of and treatment of all the diseases listed in these claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

One of ordinary skill in the art would have to experiment unduly to find out which diseases of all those listed are treatable with the instant compounds. Furthermore, it is well-established in the art that these disorders are not preventable and applicant has not shown evidence to the contrary. Moreover, it is conventional knowledge in the art that one compound has only one major use or that it can only be used to treat one disorder at a given time, hence applicant has only enabled the use to one major disorder. As a result, the showing is not commensurate in scope to the claims.

It is suggested that applicant limit the method of use to one major use that is fully enabled in the instant specification such as seizure or migraine or anxiety, for example.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah C. Lambkin whose telephone number is 571-272-0698.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached at 571-272-0699.

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DERORAH C. LAMBIN
PRIMARY EXAMINER

Deborah C. Lambkin
Primary Patent Examiner
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